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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,149	01/05/2001	Miwako Doi	05225.0193	3467
22852	7590	12/11/2007	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			DIVECHA, KAMAL B	
			ART UNIT	PAPER NUMBER
			2151	
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			12/11/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/754,149	DOI ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	KAMAL B. DIVECHA	2151	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 5-16 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) 17-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-16, 25-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

This Action is in response to communication filed on 9/26/07.

Claims 5, 7-16, 25-28 are pending in this application.

Claims 1-4 and 6 were previously cancelled.

Claims 17-24 were previously withdrawn.

**Response to Arguments**

Applicant's arguments filed September 26, 2007 have been fully considered but they are not persuasive.

In response filed, applicant argues in substance that:

- a. Encrypting and transmitting a user identifier by Marko does not constitute a teaching or suggestion of "service request information without the user identifier and without the temporary identifier by excluding the temporary identifier from the communication control information" (remarks, pg. 11-12).

In response to argument [a], Examiner respectfully disagrees.

As set forth in the previous office action, Stewart in view of Aravamudhan does not disclose the process of sending a request for information without the user id and temporary id to the service provider (office action, pg. 5).

**TURPEINEN, MARKO**

Marko explicitly discloses the problems associated with providing the user id and/or personal data to the content provider (pg. 2 lines 1-15).

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In order to overcome these problems, Marko discloses the process of concealing the user id from the second server (i.e. 3<sup>rd</sup> party server, pg. 2 lines 24-35).

At best understood, Marko discloses the process of concealing the user id from outsiders by encrypting the user id and the profile data into such a form that the CP, i.e. outsiders, cannot recognize the client's identity if the service in question is anonymous (pg. 4 lines 4-26).

Marko further discloses "the advantage of the encryption function to the client is, for example, that the client is able to contact the server of a content provider without the CP coming to know the client's identity (pg. 4 lines 33-36).

In other words, in this specific case, the content provider CP neither knows the client id nor the "key" which enables the CP to decrypt the user's id.

Encryption is fairly known in the art. Every encrypted message, data, file, etc., is associated with a secret "key", and without such a key, it is impossible to decrypt the data.

Furthermore, Marko discloses that, the CP provides the content to the client without finding out the client identity used by the service provider. The CP will not be able to find out the client's identity (pg. 5 lines 4-23).

Stated another way, the CP is not provided with a "key", which would have allowed the CP to recognize the client's id.

Moreover, Marko teaches the process wherein "in addition to concealing the client id, it may be preferable to filter or distort the profile data transmitted to CP..." (pg. 5 lines 25-35: omitting and/or excluding certain information in the profile).

In other words, Marko, in addition to encryption function, also teaches and discloses the process of filtering and/or omitting user data.

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Given these teachings, it would simply be obvious to a person of ordinary skill in the art at the time the invention was made to modify Stewart and Aravamudan in view of Marko in order to exclude, filter and/or omit the user and/or temporary id from the service request.

The motivation is clearly disclosed by Marko, i.e. it would have protected the user and/or temporary id and user's personal data from outsiders (pg. 5 lines 15-33).

### **Claim Rejections - 35 USC § 112**

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 5, 7-16 and 25-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Amended claim 5 recites “A service...generates service request information without the user identifier and without the temporary identifier by excluding the temporary identifier from the communication control information...”

According to applicant specification, the communication control information is stored in a table (fig. 4A and fig. 4B).

The specification fails to clearly suggest “generating service request... by excluding the temporary identifier from the communication control information”.

In fact, specification suggests that, the service request excludes the temporary ID as shown in fig. 4B (specification, pg. 20 second paragraph).

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As such, it is simply unclear how the process of generating service request without the user id and temporary id by excluding the temporary id from the communication control table is achieved, thus enabling the scope of the claims unclear.

Claims 7-16 and 25-28 are rejected for the same reasons as set forth above.

For examination purposes, the limitation “generating...by excluding...” will be interpreted as generating the service request without user id and temporary id by excluding the temporary id from the service request.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made, in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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2. Claims 5, 7-16 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stewart et al. (hereinafter Stewart, US 6,259,405 B1) in view of Aravamudhan et al. (hereinafter Aravamudhan, US 6,563,919 B1), and further in view of TURPEINEN, Marko (hereinafter Marko, WO 99/63416).

As per claim 5 and 14, Stewart discloses a service-providing system (fig. 1A-1C) comprising:

- a mobile terminal having a user identifier (fig. 1A item #110A, fig. 4 item #430);
- a location information provider configured to provide a location information of the mobile terminal to the mobile terminal (col. 6 L6-24: a GPS device is well known for providing location information to the mobile device which then provides the location information to the service provider, the limitation does not disclose whether the provider is internal or external);
- a user identification service provider configured to provide a first service requiring a user identification to the mobile terminal (fig. 12A-fig. 12B, fig. 5);
- a user non-identification service provider configured to provide a second service not requiring a user identification to the mobile terminal (i.e. the user id is not required by the service provider, however can provide services, fig. 5 and col. 13 L65 to col. 14 L65);
- a service provider configured to provide a service dependent on the location information (fig. 7, fig 8A-8b, fig. 10A, fig. 11); and
- a wireless gateway configured to control communication among the mobile terminal, the location information provider, and the service provider through a network (fig. 1A-1C and col. 5 L60 to col. 6 L64), wherein the mobile terminal sends a service request including the user identifier, the location information, and a parameter to the wireless gateway (fig. 11 item #1110,

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col. 6 L39-64, col. 17 L35-62, col. 20 L42 to col. 21 L4) , and wherein the wireless gateway stores communication control information including a service request identifier, a service provider name, the location information, and the parameter (col. 8 L25-32), and

- generates and sends service request information to the service provider, the service request including the service request identifier, the service provider name, the location information and the parameter (col. 6 L25-39: Internet, col. 20 L42 to col. 21 L19, fig. 10A-10B, fig. 11 item #1120, fig. 12A item #1210, 1220, fig. 12B: every request initiated by the user in an Internet is associated with service identifier such as session identifier and service provider names such as the host name, See RFC 2068 describing HTTP 1.1).

However, Stewart does not disclose the process of converting the user identifier to a temporary identifier and storing the temporary identifier to conceal the user identifier and sending the request information without the user identifier and temporary identifier by excluding the temporary id from the service request.

Aravamudhan, from the same field of endeavor discloses a gateway that converts the user id to a temporary identifier and storing the user id and the temporary id in a correspondence table (fig. 5 item #72, item #95, fig. 6 item #58, col. 9 L40-51, col. 12 L29-40: the conversion obviously and logically conceals the user's id).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Stewart in view of Aravamudhan in order to convert the user id to a temporary id.



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One of ordinary skilled in the art would have been motivated because it would have enabled a mechanism for constructing a normalized query (i.e. a request) for retrieving data or service using the temporary identifier (Aravamudhan, col. 10 L17-34).

However, Stewart in view of Aravamudhan does not disclose the process of sending request information without the user identifier and without the temporary identifier by excluding the temporary id from the service request to the service provider.

Marko, from the same field of endeavor discloses the user identification service provider and a user non-identification service provider and the process of concealing, preventing the user identification from outsiders, by encrypting the user identifier and/or profile data and generating/sending the request to the service provider (Abstract, pg. 2 line 16 to pg. 3 line 12, pg. 4 line 4 to pg. 5 line 36: the purpose of the encryption function is to convert the identity and/or profile data of the client into such a form that the content provider cannot recognize the client's identity. In other words, the request sent to the content provider neither includes a client id nor temporary id), and further discloses the process of filtering and/or omitting the user's personal data from the service request (pg. 5 15-33: i.e. excluding data from the service request sent to CP).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Stewart in view of Aravamudhan and further in view of Marko in order conceal user id and send the request to the service provider without user or temporary id by filtering and/or omitting (i.e. excluding) the temporary id from the service request.

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One of ordinary skilled in the art would have been motivated because it would have prevented the user identification from being compromised for various purposes (Marko, pg. 2 line 2-36, pg. 5 lines 15-33).

As per claim 9, Stewart discloses a system wherein the service provider stores service information including the service request identifier, a wireless gateway identifier of the wireless gateway, the location information and the parameter in response to the service request information sent by the wireless gateway (col. 9 L55 to col. 10 L23).

As per claim 10, Stewart discloses the system wherein the service provider creates the service information by referring to the location information and the parameter, and sends service response information including the service request identifier, the location information and the service information to the wireless gateway (col. 15 L55 to col. 16 L67, col. 20 L42 to col. 21 L19, col. 22 L32-67, fig. 10-12).

As per claim 11, Stewart does not disclose a system wherein the wireless gateway reconverts the temporary id corresponding to the service request identifier in the service response information to the user identifier in response to the service response information sent by the service provider.

Aravamudhan discloses a system wherein the wireless gateway reconverts the temporary id corresponding to the service request identifier in the service response information to the user identifier in response to the service response information sent by the service provider (col. 9 L22 to col. 10 L16, fig. 6).

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Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Stewart in view of Aravamudhan in order to reconvert the temporary id in the service response to the user id.

One of ordinary skilled in the art would have been motivate because it would have provided the response back to the specific user (Aravamudhan, col. 10 L6-16).

As per claim 15, Stewart discloses the system wherein the wireless gateway sends a user identification service request which is the same as the communication control information to the user identification service provider if the service request is a user identification service request (fig. 5 and col. 12 L25 to col. 13 L49).

As per claim 16, Stewart discloses the system wherein the wireless gateway sends a user non-identification service request, which is the communication control information without the temporary identifier to the user non-identification service provider if the service request is a user non-identification service request (Stewart, fig. 5, fig. 10-12; Marko, pg. 2 line 16 to pg. 3 line 12, pg. 4 line 4 to pg. 5 line 36).

As per claim 25, Stewart does not disclose the system wherein the temporary id is unable to identify the mobile station without the information on converting the user id to the temporary id.

Aravamudhan, from the same field of endeavor discloses the system where the user id identifies the mobile terminal and the temporary id is unable to identify the mobile terminal without information on converting the user id to temporary id (fig. 5, col. 9 L40 to col. 10 L65).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Stewart in view of Aravamudhan in order to employ a mechanism for protecting the user identification.

One of ordinary skilled in the art would have been motivated because its known in the art that without a correspondence table between the two identifiers, no one would be able to determine the original user's identity.

As per claim 26, the combination of Stewart, Aravamudhan and Marko discloses the system wherein the service request identifier prevents the service provider from knowing either the user id or the temporary id; and is only used by the mobile gateway to identify the mobile station based on the temporary identifier and the communication control (Aravamudhan, col. 9 L22 to col. 10 L16, fig. 6; Marko, Abstract, pg. 2 line 16 to pg. 3 line 12, pg. 4 line 4 to pg. 5 line 36).

As per claim 27, the combination of Stewart, Aravamudhan and Marko discloses the process wherein the service request does not include either the user identification or the temporary identifier (Marko: pg. 2 line 16 to pg. 3 line 12, pg. 4 line 4 to pg. 5 line 36).

As per claim 28, Stewart does not disclose a system wherein the temporary id is only used by the wireless gateway and the wireless gateway converts the user id to the temporary id without informing the mobile terminal the temporary id.

Aravamudhan, from the same field of endeavor discloses the system wherein the temporary id is only used by the wireless gateway and the wireless gateway converts the user id to the temporary id without informing the mobile terminal the temporary id (fig. 2, fig. 5 item 372, fig. 6 item 358, 60, 66).

Therefore it would have been obvious to a person of ordinary skilled in the art at the time the invention was made to modify Stewart in view of Aravamudhan in order to transparently convert the user id.

One of ordinary skilled in the art would have been motivated because of the same reasons as set forth in claim 5.

As per claims 7, 8, 12, 13, they do not teach or further define over the limitations in claims 5, 9-11, 14-16 and 25-28. Therefore claims 7, 8, 12, 13 are rejected for the same reasons as set forth in claims 5, 9-11, 14-16 and 25-28.

#### *Additional References*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Merriman et al., US 5,948,061: Delivery, Targeting and Measuring advertising over networks.
- b. Brohoff, US 6,108,533: Geographic Database for Radio System.
- c. Tobita et al., US 6,694,133 B1: Image providing system.
- d. Lopke, US 6,553,310 B1: Method and Apparatus for Topologically based retrieval of information.
- e. Miller et al., US 6,006,084: Providing Billing services for a mobile group of communication system users.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kamal Divecha/

Kamal Divecha  
Art Unit 2151  
December 7, 2007.

  
**JOHN FOLLANSBEE**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection (i.e. 35 U.S.C. 112, second paragraph) presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAMAL B. DIVECHA whose telephone number is 571-272-5863. The examiner can normally be reached on Increased Flex Work Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.